

The opinion in support of the decision being entered
today is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY L. OEHRKE

Appeal 2007-1044
Application 09/594,070
Technology Center 2100

Decided: July 31, 2007

Before LANCE LEONARD BARRY, MAHSHID D. SAADAT, and JAY P.
LUCAS, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-19, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention relates to messaging in computer networks for guaranteed messaging service on an internet provider (IP) network (Specification 1). According to Appellant, instead of returning a message as

undeliverable, the message is rerouted to a relay server (Specification 2) which attempts to re-send or re-route the message (*id.*).

Independent Claim 1 reads as follows:

1. A method for providing a messaging service on a computer network, the method comprising the steps of:
 - (a) routing a message to a messaging server;
 - (b) providing the message to a relay server when the message is undeliverable to the messaging server; and
 - (c) re-routing the message from the relay server to the messaging server when operational.

The prior art references relied upon by the Examiner in rejecting the claims on appeal are:

| | | |
|----------|-----------------|--|
| Nelson | US 5,974,122 | Oct. 26, 1999 |
| Doshi | US 6,130,875 | Oct. 10, 2000 (filed Oct. 29, 1997) |
| McDowell | US 6,438,583 B1 | Aug. 20, 2002 (filed Jun. 23, 1999) |

The Examiner rejected claims 1-4, 7-12, and 15-19 under 35 U.S.C. § 103(a) as being unpatentable over McDowell and Nelson and claims 5, 6, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over McDowell, Nelson, and Doshi.

We reverse.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103. The issue turns on whether there is a legally sufficient justification for combining the disclosures of

McDowell and Nelson and if so, whether the combination teaches the claimed subject matter. Specifically, the issue is:

whether storing the undeliverable facsimile in the messaging platform of Nelson and attempting to deliver it later, when combined with the teachings of McDowell, is the same as providing a message to a relay server when the message is undeliverable and rerouting the message to the messaging server when operational, as recited in the claims.

FINDINGS OF FACT

The following findings of fact (FF) are believed to be supported by a preponderance of the evidence.

1. McDowell relates to a method and apparatus for re-routing of e-mail messages destined for a prior address to the new address of an intended recipient (Abstract).

2. Instead of ignoring an undeliverable message, McDowell re-routes the e-mail sent to an old Internet Service Provider (ISP) to a re-route server that sends the message to the new address on another ISP (col. 1, ll. 48-55). Alternatively, the old ISP may forward the message directly to the other ISP (col. 1, ll. 59-61).

3. As shown in Figures 1A-14B, the reroute server always re-routes the message to the new ISP without attempting to send it to the old ISP because the address on the old ISP is not operational anymore as the user is no longer a subscriber to the old ISP (col. 1, ll. 51-53). For example, Figure 1 shows that the message is sent to a re-route server which in turn sends it to the new ISP based on the forwarding information present in the old ISP (col. 7. ll. 11-33).

4. If the undeliverable message to the old ISP has a valid re-route request, the message is passed to the re-route server where the new address for the recipient is determined from stored information and used for forwarding the message to the recipient's new address (col. 8, ll. 1-13).

5. Nelson describes a facsimile system wherein the facsimile message is stored on a messaging platform only if the destination is unavailable at the first time and is transmitted a second time when the destination becomes available (Abstract; col. 1, l. 65 through col. 2, l. 7).

6. Nelson further shows in Figure 3 the facsimile routing through a communications network that includes originating Service Switching Point (SSP) 216 corresponding to the originating fax machine and destination SSP 208 corresponding to the destination fax machine 206 (col. 4, ll. 26-33). If the destination condition is "busy" or "no answer" at the first time, the originating SSP routes the telephone call and the facsimile message to a messaging platform 214 which stores the message and attempts transmitting at a later time (col. 4, ll. 50-65 and col. 6, ll. 6-26).

PRINCIPLES OF LAW

A claimed invention is unpatentable as obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *See* 35 U.S.C. § 103(a) (2002); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1691 (Fed. Cir. 2007) (quoting *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-40, 82 USPQ2d 1385, 1395 (2007)). “One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397. Design incentives and market forces as well as implementing a predictable variation may also help the person of ordinary skill in the art to recognize the obviousness of claimed combinations of elements of prior art. *KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1396.

Alternatively, a holding of obviousness can be based on a showing that there was “an apparent reason to combine the known elements in the fashion claimed.” *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. In other words, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). However, this reasoning is not limited to the problem the patentee was trying to solve; “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed,” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397 (emphasis added).

Furthermore, a reference may be understood by the artisan as suggesting a solution to a problem that the reference does not discuss. *See KSR*, 137 S. Ct. at 1742, 82 USPQ2d at 1397 (“Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. . . . A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. “Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand.” *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). *See also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

ANALYSIS

The rationale argued by the Examiner for combining the references is based on the common goal of ensuring the delivery of messages when the delivery to the destination fails (Answer 4 and 8). Appellant contends that the references are directed to different kinds of problems and do not share a common goal (Br. 10; Reply Br. 6). We agree with Appellant. While McDowell attempts to re-route e-mail messages to a recipient who is no longer a subscriber of an old ISP (FF 1 & 2) and Nelson describes resending of facsimile messages to a number which was busy the first time (FF 5), the problems the two references solve and the mechanism by which the messages are re-routed are not the same.

We also agree with Appellant (Reply Br. 6-7) that McDowell's re-routing the e-mail message that was sent to the correct address in the correct ISP but to a recipient who is no longer a subscriber differs from Nelson's re-routing a facsimile message to a number that is busy. McDowell merely forwards the e-mail message to a re-route server only if the new address of the subscriber can be identified, either based on the forwarding information (FF 3) or if the re-route server has the information in the storage (FF 4). Nelson on the other hand, sends the facsimile message to the correct number or subscriber and if the number is busy or does not answer, sends the message to the message platform to be temporarily stored (FF 5).

Therefore, the specific problem encountered by each of the references is caused by different failures and have different solutions. McDowell, attempts to re-route the message to the ISP where the recipient is currently subscribed to whereas Nelson stores the message for later delivery to the same number. In that regard, the only predictable result that may be achieved by storing the e-mail in McDowell and resending it to the same old ISP is that the message will still be undeliverable since the recipient no longer subscribes to the old ISP.

Additionally, the Examiner's explanation (Answer 9) as to why the facsimile service network of Nelson may include servers notwithstanding, the differences between the cause of messages being undeliverable and the mechanism for re-routing the messages of McDowell and Nelson would not have prompted a person of ordinary skill in the relevant field to combine the elements in the way the instant claims require. Thus, we find that Examiner's rejection rests on less than a preponderance of evidence and

thus, fails to provide sufficient reasons for finding claims 1-4, 7-12, and 15-19 unpatentable for obviousness under 35 U.S.C. § 103(a) over McDowell and Nelson.

With respect to the rejection of claims 5, 6, 13, and 14 over the combination of McDowell and Nelson with Doshi, we note that the Examiner has not pointed to any teachings in Doshi that would have overcome the deficiency of McDowell and Nelson combination as discussed above. Thus, we do not sustain the 35 U.S.C. § 103 rejection of claims 5, 6, 13, and 14 as being unpatentable over McDowell, Nelson, and Doshi.

DECISION

The decision of the Examiner rejecting claims 1-19 under 35 U.S.C. § 103 is reversed.

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REVERSED

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